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subject to Applicants' right to file continuation or divisional applications thereto, in an effort to expedite prosecution at this point in time.

### **REJECTIONS UNDER 35 U.S.C. § 112**

The Examiner has rejected claims 6, 7, and 13 under 35 U.S.C. § 112, because the Examiner believes that the claims are indefinite. Namely, the Examiner has found that claims 6, 7, and 13 recite the limitation "said step of removing" and that there is insufficient antecedent basis for this recitation. Applicants have amended claim 1 to recite the step of "Removing" in lieu of the step of "stripping."

The Examiner has also rejected claims 14 and 15, ostensibly under 35 U.S.C. § 112, second paragraph, because the Examiner has found that there is insufficient antecedent basis for the recitation "100% solids tape." Applicants have amended claims 14 and 15 to simply recite "solids tape," which is recited in claim 8.

### **REJECTIONS UNDER 35 U.S.C. § 102**

The Examiner has rejected claims 1, 2, 8-10, and 24 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,903,340 to Shepherd. The Examiner alleges that Shepherd discloses a method for applying a walkway pad to a roofing membrane including the step of affixing a solids tape to a flat surface of the pad at the manufacturing location where the tape has a release paper, stripping the release paper, placing the exposed tape onto the roof membrane, and inherently applying pressure. The Examiner further alleges that claim 27 is anticipated because Shepherd discloses a method of making walkway pads including the step of inherently constructing the pad in a factory and applying a solids tape also at the factory.

Reconsideration is respectfully requested. Anticipation requires that each recitation of a claim be located within a prior art reference. Several of the recitations set forth in independent claims 1, 8, 16, and 27 are not taught by Shepherd.

First, the roofing article taught by Shepherd, which is not a walkway pad but instead a shingle, does not include a tape that carries a protective layer of

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release paper. Instead, the shingle taught by Shepherd includes a self-adhering resinous material that is applied to the *top surface* of the shingle.<sup>1</sup> The *back surface* of the shingle includes a separating stripe.<sup>2</sup> When the shingles are stacked or bundled, the separating stripe and the resinous material contact one another so as to prevent the self-adhering resinous material of one shingle from sticking to the back surface of the immediately (vertically) adjacent shingle.<sup>3</sup> Therefore, even if the Examiner construes the self-adhering resinous material of Shepherd to be analogous to a solids tape, the tape does not carry a protective layer of release paper. The release paper is carried on the opposite side of the shingle.

Furthermore, inasmuch as the tape does not carry a protective layer of release paper, the step of "removing said release paper from said tape immediately prior to use," as recited in claim 1, is not an inherent feature of the teachings of Shepherd. There is no need to remove the tape prior to application.

Furthermore, inasmuch as the self-adhering resinous material of Shepherd is applied to the top surface of the shingle, the self-adhering resinous material will not be placed directly onto the upper surface of any roofing membrane upon which the shingles might be applied. Instead, the resinous material is on the opposite side of the shingle that contacts the roof surface. As those skilled in the art will appreciate, the self-adhering resinous material is placed on the top surface of the shingle so that the "butt segment" of the overlapping shingle can adhere to the lower shingle.<sup>4</sup>

In a similar fashion, claim 8 recites the step of "applying the walkway pad to a roofing membrane, which is located on the rooftop, by placing an exposed surface of the solids tape directly onto the upper surface of the roofing membrane." Claim 16 recites that the solids tape "carries a protective layer of release paper." And, claim 27, recites the step of "applying a release paper directly to said solids tape."

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<sup>1</sup>U.S. Patent No. 3,903,340, column 3, lines 5-6 and Fig. 1.

<sup>2</sup>*Id* at column 3, lines 19-20 and Fig. 2.

<sup>3</sup>*Id* at column 4, lines 12-25 and Fig. 3.

<sup>4</sup>U.S. Patent No. 3,903,340, column 1, lines 8-21 and Fig. 1.

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**REJECTIONS UNDER 35 U.S.C. § 103**

The Examiner has rejected claims 6, 7, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Shepherd. The Examiner has found that Shepherd does not disclose the steps of preparing and priming as set forth in claims 6 and 7, as well as claims 13-15. Nonetheless, the Examiner believes that it would have been obvious to prepare and prime the roof surface prior to stripping the release paper since the Examiner believes that the steps are old and well known in the art.

Reconsideration is respectfully requested. The self-adhering resinous material taught by Shepherd is not employed to secure the roofing shingle to the roof surface. Instead, as those skilled in the art are well aware, roofing shingles such as those taught by Shepherd are typically nailed to the roof surface. There is, therefore, no need to prepare and prime the roofing surface when using a shingle. Accordingly, Shepherd does not teach or suggest priming the underlying surface in advance of attaching a walkway pad.

The Examiner has also rejected claims 3 and 11 under 35 U.S.C. § 103 as being unpatentable over Shepherd in view of U.S. Patent No. 4,855,172 to Chiu or commercially available adhesive tapes by Adco Products, Inc. and Ashland Chemical. The Examiner alleges that Shepherd discloses the basic claimed method of applying a walkway pad but has found that Shepherd does not teach a solids tape including EPDM. The Examiner therefore relies on Chiu, Adco Products, Inc., and Ashland Chemical to overcome this shortcoming. In so doing, the Examiner concludes that it would have been obvious to provide the structure of Shepherd with the EPDM adhesives taught by the supporting references in order to improve the adhesion of the walkway pad to the roof and to improve securement of the pads thereto.

Reconsideration is respectfully requested. Applicants have adequately distinguished the claimed invention from Shepherd above. The distinctions that exist cannot be overcome by relying on any of the supporting prior art now cited by the Examiner. And, inasmuch as the self-adhering resinous material taught by Shepherd is not employed to secure the shingle to the roofing surface or

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membrane, there is no suggestion in either Shepherd or the supporting references to employ an EPDM solids tape as currently claimed by the Applicants.

The Examiner has also rejected claims 4 and 12 under 35 U.S.C. § 103(a) as being unpatentable over Shepherd in view of Chiu or the commercially available tapes by Adco Products and Ashland Chemical and the FIRESTONE RUBBERGARD walkway pad. The Examiner believes that Shepherd discloses the basic claimed method except for the particulars of the walkway pad and adhesive. The Examiner believes that the FIRESTONE RUBBERGARD walkway pad provides the particulars for the walkway pad and that Chiu or the commercially available tapes provide the particulars for the adhesive, and therefore concludes that it would have been obvious to form a walkway pad of Shepherd out of the material of FIRESTONE RUBBERGARD and form the adhesive of Shepherd or the commercially available tapes.

Reconsideration is respectfully requested. As noted above, the self-adhering resinous material taught by Shepherd is not employed to adhere the roofing shingle to the roof surface. Therefore, there is no teaching, suggestion, or motivation to combine the teachings of Shepherd with those of the FIRESTONE RUBBERGARD walkway pad or with Chiu or the commercially available adhesive tapes. Indeed, the problems solved are entirely distinct. Walkway pads are not applied by overlapping one on another, as with shingles. Therefore, a tape or adhesive is not applied to the top surface of a walkway pad.

The Examiner has also rejected claims 16, 17, and 20-23 under 35 U.S.C. § 103(a) as being unpatentable over Shepherd. The Examiner has found that Shepherd is silent with respect to the delivery step, but nonetheless believes that it would have been obvious to have stacked the pads to be delivered for use. The Examiner also believes that it would have been obvious to apply the solids tape without priming the surface of the walkway pad.

Reconsideration is respectfully requested. The ability to provide walkway pads containing a solids tape affixed to the walkway pad where the step of affixing occurs at the location where walkway pad is manufactured is not only novel but is not suggested in the art. As disclosed throughout the Applicants' written description, the ability to provide a walkway pad having a "factory-applied"

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solids tape provides many advantages in the art. While Shepherd teaches a shingle having an ostensibly "factory-applied self-adhering resinous material applied thereto," this adhesive does not provide any advantage for applying the shingle to the roof surface. Accordingly, the motivation to apply the adhesive to the shingle as taught by Shepherd is entirely distinct from the advantages discovered by Applicants' invention. Accordingly, it would not have been obvious in view of the references cited by the Examiner to deliver a walkway pad to a roof site where the walkway pad includes a solids tape.

The Examiner has rejected claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Shepherd in view of Chiu or the commercially available tapes noted above. The Examiner believes that it would have been obvious to provide the structure of Shepherd with the EPDM adhesives of Chiu or the commercially available products.

Reconsideration is respectfully requested. Applicants' arguments respecting these references are noted above and incorporated herein. In short, the distinctions between the claimed invention and the teaching's of Shepherd provide insufficient support upon which the Examiner's rejections can stand.

The Examiner has rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Shepherd in view of Chiu or the commercially available adhesive tapes and the FIRESTONE RUBBERGARD walkway pad.

Reconsideration is respectfully requested. The Applicants' arguments with respect to these references are noted above and incorporated herein. Again, the distinctions between the claimed invention and the teachings of Shepherd preclude any ability to combine the cited references and arrive at the claimed invention.

### CONCLUSION

In view of the foregoing amendments and arguments presented herein, the Applicants believe that they have properly set forth the invention and accordingly, respectfully requests the Examiner to reconsider the rejections provided in the last Office Action. In sum, Applicants have adequately

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distinguished Shepherd and have established that Shepherd does not anticipate the claimed invention and, moreover, cannot serve as a primary reference for any obviousness rejection. Since each of the Examiner's rejections rely primarily on Shepherd, the Applicants believe that each of the Examiner's rejections have been overcome. A formal Notice of Allowance of claims 1-4, 6-24, and 27 is earnestly solicited. Should the Examiner care to discuss any of the foregoing in greater detail, the undersigned attorney would welcome a telephone call.

No new claims have been added and therefore no additional fees are believed due at this time. Nonetheless, in the event that a fee required for the filing of this document is missing or insufficient, the undersigned attorney hereby authorizes the Commissioner to charge payment of any fees associated with this communication or to credit any overpayment to Deposit Account No. 06-0925.

Respectfully submitted,



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**MARKED-UP CLAIMS**

- 1 1. (Twice Amended) A method for applying walkway pads to roofing  
2 membranes, the method comprising:  
3 affixing a solids tape to one flat surface of a walkway pad, where the  
4 tape carries a protective layer of release paper, and where said step of affixing  
5 occurs at the location where the pad is manufactured;  
6 [stripping] removing said release paper from said tape immediately prior  
7 to use;  
8 subsequently placing the exposed surface of said tape directly onto the  
9 upper surface of the roofing membrane; and,  
10 applying force directly to said walkway pad to enhance the bond  
11 between said pad and the membrane created by said tape.
- 1 8. (Amended) A method for applying a walkway pad to a roofing membrane,  
2 said method comprising:  
3 providing a walkway pad to a rooftop, where the walkway pad includes  
4 a solids tape applied to a substantially planar surface of the walkway pad; and  
5 applying the walkway pad to a roofing membrane, which is located on  
6 the rooftop, by placing an exposed surface of the solids tape directly onto the  
7 upper surface of the roofing membrane.
- 1 14. (Amended) The method of claim 8, where the [100%] solids tape is applied  
2 to a flat surface of the walkway pad at the same location where the walkway pad  
3 is manufactured.
- 1 15. (Amended) The method of claim 14, where the [100%] solids tape is applied  
2 to a flat surface of the walkway pad without priming the flat surface of the  
3 walkway pad.
- 1 27. (Amended) A method of making a walkway pad, said method comprising the  
2 steps of:  
3 constructing a walkway pad within a factory; [and]

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4 applying a solids tape to a substantially planar surface of the walkway  
5 pad; and  
6 applying a release paper directly to said solids tape, where said steps of  
7 applying a solids tape and applying a release paper occur while the walkway  
8 pad remains within the same factory that the walkway pad was constructed.